

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

I. DISPOSITION OF THE CLAIMS

Claim 1 is currently being amended. No new matter has been added.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1, 17-23, 26-32, and 34 are now pending in this application. Claims 23 and 26-32 are withdrawn as non-elected. Thus, claims 1, 17-22, and 34 are under examination.

II. OBJECTION TO CLAIM 1

The Office objected to claim 1 for its preamble. Office Action, page 2.

Applicants have amended claim 1 as suggested by the Office to recite “An oral composition for stimulating thermogenesis comprising...”.

Accordingly, this objection has been obviated by amendment. The examiner requests rewording claim 1 to recite “An oral composition for stimulating thermogenesis comprising...” and should be withdrawn.

III. CLAIM 1 CONTAINS NO NEW MATTER

Claim 1 stands rejected under 35 U.S.C. § 112, first paragraph, for allegedly containing new matter in the limitation “approximately 5%”.

Applicants respectfully traverse.

The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon “reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.”... The subject matter of the claim need not be

described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. M.P.E.P. § 2163.02, citing *Ralston Purina Co. v. Far-Mar-Co.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

Here, the specification provides literal support for the word “approximately” as it appears in claim 1, as noted in the Amendment filed April 14, 2010, citing to the published application US 2007-0141184, page 2, paragraph [0056]. The specification provides further support at page 3, paragraph [0084], and page 4, table above paragraph [0092] (also noted in the April 14 Amendment).

Accordingly, this ground of rejection should be withdrawn.

The Office apparently based the new matter rejection on the unexpected results disclosed on page 11 of the specification (Office Action, page 3, lines 3-5):

However, the specification fails to provide support regarding “approximately 5%”, as the unexpected result in page 11 of the specification requires the presence of “5% by weight beeswax and 5% by weight glycerol palmitostearate”.

Unexpected results, however, is an issue inapposite to Section 112, but more properly directed to rejections for obviousness under Section 103. No such obviousness rejection is of record in this application. Nevertheless, Applicants address the Office’s comments to expedite prosecution.

The Manual of Patent Examining Procedure instructs examiners as follows (M.P.E.P. § 2145):

When considering whether proffered evidence is commensurate in scope with the claimed invention, Office personnel should not require the applicant to show unexpected results over the entire range of properties possessed by a chemical compound or composition. See, e.g., *In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987). Evidence that the compound or composition possesses superior and unexpected properties in one of a spectrum of common properties can be sufficient to rebut a prima facie case of obviousness. *Id.*

The M.P.E.P. explains the application of this principle with an example similar to the present application (M.P.E.P. § 2145):

[A] showing of unexpected results for a single member of a claimed subgenus, or a narrow portion of a claimed range would be sufficient to rebut a prima facie case of obviousness if a skilled artisan “could ascertain a trend in the exemplified data that would allow him to reasonably extend the probative value thereof.” *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (C.C.P.A. 1980) (Evidence of the unobviousness of a broad range can be proven by a narrower range when one skilled in the art could ascertain a trend that would allow him to reasonably extend the probative value thereof.).

Thus, the Office’s interpretation on the scope of the unexpected results in the specification is unduly narrow and overly restrictive. In any event, as noted above, this doctrine is irrelevant to the issue of new matter. In particular, the specification provides literal support for “approximately” in the context of the invention as claimed.

Applicants respectfully request withdrawal of this rejection.

IV. INDEFINITENESS

Claim 1 stands rejected as indefinite for its text at lines 4-15. According to the Office, the claim is indefinite, because (Office Action, page 4, lines 7-11):

The recitation is very confusing, as it encompasses two ranges, one broad range and one narrow range. The narrow range demands “wherein the composition comprises approximately 5% by weight beeswax and approximately 5% by weight glycerol palmitostearate”. The broad range requires “the lipophilic additive amounting to approximately 10 to 20% by weight of the composition”.

Applicants respectfully traverse this ground of rejection.

The Office appears to have misinterpreted the indefiniteness requirement.

“The test for definiteness under 35 U.S.C. 112, second paragraph, is whether ‘those skilled in the art would understand what is claimed when the claim is read in light of the specification.’ *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).” See M.P.E.P. § 2173.02.

Here, the meaning of claim 1 would be clear to a skilled artisan.

Claim 1 clearly provides for a “lipophilic additive amounting to approximately 10 to 20% by weight of the composition” and “wherein the composition comprises approximately 5% by weight beeswax and approximately 5% by weight glycerol palmitostearate” as lipophilic additives.

These two limitations acting together require approximately 5% each of beeswax and glycerol palmitostearate, while allowing for other additional lipophilic additives such that up to 20% lipophilic additives may be present.

Accordingly, if the lipophilic additive content amounts to approximately 10% by weight of the composition, then only beeswax and glycerol palmitostearate are present.

Alternatively, if the lipophilic additive content amounts to more than approximately 10% by weight of the composition, then lipophilic additives other than beeswax and glycerol palmitostearate are also present to account for the lipophilic additive content above approximately 10% by weight of the composition.

Thus, a skilled artisan would face no difficulty in understanding the scope and meaning of claim 1.

Accordingly, this ground of rejection should be withdrawn.

V. CONTINUED REQUEST FOR REJOINDER

As noted in the Amendment filed April 14, 2010, upon allowance of elected claims 1, 17-22, and 34, Applicants request rejoinder of withdrawn method claims 28-32 and withdrawn composition claims 23 and 26-27.

Withdrawn method claims 28-32 depend directly or indirectly from claim 1. Rejoinder would be proper, because claims 28-32 would contain all the limitations of an allowed claim. M.P.E.P. § 821.04(b).

Applicants also request rejoinder of withdrawn composition claims 23 and 26-27, which depend directly or indirectly from claim 1. Rejoinder would be proper, because claims 23 and 26-27 would contain all the limitations of an allowed claim. M.P.E.P. § 821.04(b).

Claim 26 recites the species elected by Applicants. Specifically, Applicants elected (i) fatty acid mono-, di, and triglycerides of claim 14, (ii) soya oil of claim 19 and (iii) green tea (see Response to Restriction Requirement). Claim 26 recites glycerol palmitostearate (as species of fatty acid mono-, di, and triglycerides), soya oil, and green tea.

Claim 23 recites an additional “physiologically active component” beyond the recited components of claim 1. Claim 27 further limits claim 1 in reciting a specific formulation.

Rejoinder of withdrawn composition claims 23 and 26-27 would require no further search and/or examination. Accordingly, these claims could be readily rejoined.

For all the reasons presented above, Applicants request rejoinder of withdrawn method claims 28-32 and withdrawn compositions claims 23 and 26-27.

CONCLUSION

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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